

REMARKS

Upon entry of this Amendment, claims 1-11 are all the claims pending in the application. Claim 11 has been added. Claims 1-10 have been examined and all of these claims have been rejected. Specifically, claim 7 has been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to be enabled by the specification; Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Sherman (USP 4,987,849); Claims 6 and 8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kuhns et al. (USP 5,090,732); Claims 2-5 and 10 have been rejected under 35 U.S.C. § 103 as being unpatentable over Sherman; and Claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Kuhns et al.

For the reasons set forth below, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

Argument***Rejection Under 35 U.S.C. § 112, ¶1***

In regard to the rejection under 35 U.S.C. § 112, first paragraph, the grounds of rejection assert that the language recited in claim 7 is not enabled by one of ordinary skill in the art. Specifically, the it is asserted that the specification does not describe how the "disappearing substance" on the claimed writing surface would avoid oxidation with exposure to air and, thus, how it would avoid disappearing prior to reacting with the "oxidation agent" on the activating sheet.

In response to this rejection Applicant has amended claim 7 to clarify that which is claimed. In particular, as described at page 7, paragraph [0030] of the specification,

the activating cover is preferably treated with a chemical, e.g., a reactionary agent, and it is this chemical that initiates disappearance of the ink.

It is submitted that claim 7 as presently presented satisfies all requirements of 35 U.S.C. § 112 and, accordingly, the rejection of claim 7 should be withdrawn.

Rejection Under 35 U.S.C. § 102

In regard to the rejection under 35 U.S.C. § 102, the grounds of rejection assert that claim 1 is anticipated by the disclosure of Sherman (USP 4,987,849) and claims 6 and 8 are anticipated by the disclosure of Kuhns et al. (USP 5,090,732). In other words, the it is asserted that Sherman discloses each and every feature recited in claim 1 and that Kuhns et al. discloses each and every feature recited in claims 6 and 8.

Applicant respectfully disagrees with this assertion. In particular, in regard to claim 1, Sherman fails to disclose a "marking surface" as disclosed and claimed in the present application. At FIG. 6, Sherman illustrates a surface 14 on which a "signal" is written indicating that a particular product has reached its shelf life. The signal in Sherman is covered with a disappearing ink that oxidizes and disappears when contacted with light and/or air. (Col. 3, lines 4-11). Sherman, however, does not disclose that surface 14 is a "marking surface" or that it comprises guide marks for assisting a user to write a message more legibly, as clearly disclosed in the present specification.

In any event, to expedite prosecution of the application, Applicant has amended claim 1, as illustrated above, to more clearly define the claimed "marking area". Applicant submits that the prior art, in particular Sherman, fails to teach, or even

suggest "a marking area comprising penmanship improving indicia comprising ink capable of disappearing." Accordingly, claim 1 is patentable over the prior art of record and the rejection of claim 1 should be withdrawn.

Claims 2-5 are patentable over the prior art of record at least by virtue of their dependence on independent claim 1.

In regard to claims 6 and 8, Applicant submits that Kuhns et al. fails to disclose an "activating cover" as disclosed and claimed in the present application. In particular, as recited in independent claim 6, the activating cover *initiates the reaction when placed over the writing surface, thereby causing the substance to disappear*. In comparison, as disclosed in Kuhns et al., "guidance means" 23 and 25 disappear upon reacting with heat. Specifically, guidance means 23 and 25 are created "with an ink which disappears upon being exposed to the heat of lamination" (Col. 7, lines 5-7). Thus, as disclosed in Kuhns et al., disappearance of the guidance marks is initiated by heat and not by a cover being placed over the writing surface, as required by independent claim 6. Accordingly, claim 6 as presently presented is patentable over Kuhns et al. and, accordingly the rejection of claim 6 should be withdrawn.

Claims 7-9 are patentable over the prior art of record at least by virtue of their dependence on independent claim 6.

Independent claim 10 is believed to be patentable over Sherman at least because Sherman does not teach or suggest the formation of "penmanship improving Indicia", as expressly required by the claim. The Examiner contends that "it would have been obvious ... to provide the disappearing ink of Sherman in an arrangement of

straight lines". In this contention, however, the Examiner has incorrectly applied *In re Gulack*. Specifically, the Examiner relied on *Gulack* for the assertion that the claimed printed subject matter does not distinguish over prior art printed subject matter because, in the Examiner's opinion, "the claimed printed matter is not functionally related to the substrate." In this case, however, the claimed printed subject matter, i.e., the "penmanship improving Indicia", is clearly functionally related to the substrate, i.e., the writing surface. Specifically, the function of the penmanship improving Indicia is to provide a mechanism which permits a writer to write more legibly and more uniformly on the writing surface. The Examiner has, thus, misapplied the holding of the *Gulack* court to the case at hand.

Moreover, as even recognized by the court in *Gulack*, the mere presence or absence of a specific functional relationship between the printed matter and the substrate is not dispositive of unobviousness. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.¹ Providing a disappearing mechanism for improving the legibility and uniformity of written material on a given writing surface, as claimed, is not an obvious functional relationship in view of prior art that discloses a mechanism for informing a potential user of a product of whether or not the respective shelf life of the product has expired. Accordingly, the subject matter of claim 10 is patentably distinguished from the disclosure of Sherman and the rejection of claim 10 should be withdrawn.

¹ 703 F.2d 1381 at 1386.

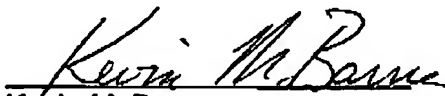
Patentability of New Claim 11

For additional claim coverage merited by the scope of the invention, Applicant has added new claim 11. Applicant submits that the prior art does not disclose, teach, or otherwise suggest the combination of features contained therein. In particular, the subject matter claimed in claim 11 is believed to be patentable for at least the same reason as independent claim 6. Support for the subject matter of new claim 11 is found, for example, at page 7, paragraph [0030] of the specification.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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